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TOWNSEND and TOWNSEND and CREW LLP

By: 

Joni E. Peterson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jeffrey J. Grainger, et al.

Application No.: 09/919,768

Filed: July 31, 2001

For: COMPUTER IMPLEMENTED
METHOD OF MANAGING
INFORMATION DISCLOSURE
STATEMENTS

Confirmation No. 4992

Examiner: Janice A. Mooneyham

Technology Center/Art Unit: 3629

APPELLANTS' BRIEF UNDER
37 CFR §41.37

Via EFS-Web

Mail Stop Appeal Brief

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal electronically filed on May 22, 2007 for the
above-referenced application, Appellants submit this Brief on Appeal (hereinafter, the "Brief").
This brief is filed with a petition for a three-month extension of time and therefore is believed to
be timely filed.

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1. REAL PARTY IN INTEREST

FTF Technologies, Inc., of Boise Idaho, is the assignee of this application and therefore is the real party in interest in this appeal. Corporation Service Company, of Wilmington, Delaware, has a majority ownership interest in FTF Technologies, Inc.

2. RELATED APPEALS AND INTERFERENCES

The following appeals may be related to, directly affect, be directly be affected by, or have a bearing on the Board decision in this appeal:

- U.S. Patent Application No. 09/872,764 (no appeal number assigned)
- U.S. Patent Application No. 09/919,764 (no appeal number assigned)
- U.S. Patent Application No. 09/996,338 (Appeal No. 2007-0776, decision attached in **11. Related Proceedings Appendix**)
- U.S. Patent Application No. 09/996,341 (no appeal number assigned)
- U.S. Patent Application No. 09/997,311 (no appeal number assigned)

3. STATUS OF CLAIMS

Claims 1-12 and 14-22 are currently pending in this application, and all of those claims stand finally rejected by an Office Action (the "Final Office Action") mailed January 24, 2007.. More specifically, Claims 1-12 and 14-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 21 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly being of undue breadth. Claim 22 stands rejected under 35 U.S.C. § 101 because the claimed invention allegedly is directed to non-statutory subject matter. Claims 1-12, 14 and 16-19 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. US 2001/0037460 to Damian Porcari (hereinafter "Porcari"). Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Porcari, and claim 15 stands rejected under § 103(a) as being unpatentable over Porcari, in view of U.S. Publication

No. US 2003/0046307 to Rivette et al. (hereinafter "Rivette"). A Notice of Appeal from the rejections in the Final Office Action was filed May 22, 2007.

A copy of the pending claims is attached as **9. Claims Appendix**. Claims 1, 21 and 22 are independent claims. At issue in this Appeal are the rejections of claims 1-12 and 14-22.

4. STATUS OF AMENDMENTS

An Amendment filed October 19, 2007 amends claims 1 and 19. As of the date of filing of this Brief, the Examiner has not made a decision on whether to enter the amendments to the claims. The copy of the claims in the **Claims Appendix** below reflects the requested amendments introduced in the October 19, 2007 Amendment.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Generally, the pending claims are directed to tools (including, without limitation, systems, methods and software) for processing documents, and more particularly, documents related to patent applications. Specifically, the pending claims are directed to tools for assisting a patent applicant (or the applicant's agent) in managing information disclosure statements, and in particular in identifying prior art references and disclosing those references to a patent office. *See generally*, Application, p. 3, ll. 2-8. In a novel aspect, the claimed tools can be used to help a patent applicant to manage disclosure obligations, by tracking whether a patent office has considered a particular reference, as indicated on a report received from the patent office. *See id.*, p. 3, ll. 20-24.

Merely by way of example, claim 1 is directed to a computer implemented method of processing documents received on a server system. The method of claim 1 comprises storing a plurality of references on the server system. *Id.*, p. 3, ll. 9-10. In the claimed embodiment, the plurality of references are electronic documents, and the plurality of references comprises a first reference comprising a set of reference information to be disclosed to a patent office. *Id.*, p. 3, ll. 10-11, p. 6, ll. 16-20. Examples of references can include, without limitation,

US patents, foreign patents, publications, scientific and/or technical literature, and the like.. *Id.*, p.8, ll. 31-34, p. 9, ll. 26-27, p. 25, ll. 7-30, p. 27, ll. 23-27, p. 33, ll.1-14, Fig. 17.

The method recited by claim 1 further comprises receiving a citation document on the server system; the citation document is an electronic document including citation information for one or more prior art reference documents. *Id.*, p. 3, ll. 11-13, p 34, ll. 19-30. As disclosed in the Application, an example of a citation document is a PTO form 892 or 1449. *Id.* In accordance with claim 1, the method further comprises providing communication between the server system and a client system. *Id.*, p. 18, ll. 31-34, p. 19, ll. 1-19, p. 23, ll. 13-22, Figs. 9, 10. The client system is configured to provide interaction between a user and the server system, and the method further comprises displaying the citation information in the citation document to a user of a client system in a first display section. *Id.*, p. 3, ll. 13-15, p. 34, ll. 31-33, p. 35, ll. 20-30, Fig. 20.

According to the method of claim 1, a second display section displays an identifier corresponding to the first reference. *Id.*, p. 3, ll. 13-17, p. 35, ll. 22-30, Fig. 20. The method also comprises providing an interface element (which is sometimes referred to in the Application as an "input select element," which can include, for example, a checkbox, electronic button, and/or the like) associated with the identifier; in an aspect, the interface element is configured to receive, from the user, input pertaining to the first reference. *Id.*, p. 3, ll. 15-10, p. 35, ll. 1-8, Fig. 20. The input comprises information about a relationship between at least some of the citation information in the citation document and the first reference. *Id.* Fig. 20 illustrates, as one example of interface elements, a set of radio buttons 2022 and 2033.

Independent claim 21 is directed to a system for processing documents, and the system of claim 21 is configured to operate in a fashion similar to the method of claim 1. The system of claim 21 includes a server system and a client system in communication with the server system. Application, p. 18, ll. 31-34, p. 19, ll. 1-19, p. 23, ll. 13-22, Figs. 9, 10. The server system comprises a first processor and a first computer readable memory comprising a first set of instructions executable by the first processor. *Id.*, p. 8, ll. 1-5. Correspondingly, the

client system comprises a second processor and a second computer readable memory comprising a second set of instructions executable by the second processor. *Id.*

The first set of instructions (i.e., the instructions executable on the server) includes instructions to store a plurality of references (i.e., electronic documents), which comprises a first reference comprising a set of reference information to be disclosed to a patent office. *Id.*, p. 3, ll. 9-11, p. 6, ll. 16-20. The first set of instructions further comprises instructions to receive a citation document, which is an electronic document comprising citation information for one or more prior art reference documents. *Id.*, p. 3, ll. 11-13, p. 34, ll. 19-30.

The second set of instructions (i.e., the instructions executable by the client system) includes instructions to display, display for a user, in a first display section, the citation document and to display, in a second display section, an identifier corresponding to the first reference. *Id.*, p. 3, ll. 13-17, p. 34, ll. 31-33, p. 35, ll. 20-30, Fig. 20. The second set of instructions also comprises instructions to provide an interface element associated with the identifier; the interface element is configured to receive, from the user, input pertaining to the first reference. *Id.*, p. 3, ll. 15-10, p. 35, ll. 1-8, Fig. 20. The input comprises information about a relationship between at least some of the citation information in the citation document and the first reference. *Id.*

Independent claim 22 is directed to a computer program embodied on at least one computer readable memory; the computer program comprises a set of instructions executable by one or more processors. Application, p. 8, ll. 3-6, p. 7, ll. 22-31. The set of instructions in the computer program of claim 22 comprises instructions executable by the one or more processors to perform operations corresponding to some of the procedures recited by the method of claim 1, described above. For example, the set of instructions includes instructions to store a plurality of references on the server system. *Id.*, p. 3, ll. 9-10. The references are electronic documents, and the plurality of references comprises a first reference comprising a set of reference information to be disclosed to a patent office. *Id.*, p. 3, ll. 10-11, p. 6, ll. 16-20.

The set of instructions further comprises instructions to receive a citation document on the server system; the citation document is an electronic document including

citation information for one or more prior art reference documents. *Id.*, p. 3, ll. 11-13, p 34, ll. 19-30, and instructions to display, in a first display section, the citation document for a user. *Id.*, p. 3, ll. 13-15, p. 34, ll. 31-33, p. 35, ll. 20-30, Fig. 20. The set of instructions also includes instructions to display, in a second display section, an identifier corresponding to the first reference. *Id.*, p. 3, ll. 13-17, p. 35, ll. 22-30, Fig. 20. Finally, the set of instructions includes instructions to provide an interface element associated with the identifier; in an aspect, the interface element is configured to receive, from the user, input pertaining to the first reference. *Id.*, p. 3, ll. 15-10, p. 35, ll. 1-8, Fig. 20. The input comprises information about a relationship between at least some of the citation information in the citation document and the first reference. *Id.*

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-12 and 14-22 are unpatentable under 35 U.S.C. § 112, ¶ 2 as being indefinite.
2. Whether claim 21 is unpatentable under 35 U.S.C. § 112, ¶ 1 as being of undue breadth.
3. Whether claim 22 is unpatentable under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.
4. Whether claims 1-12, 14, and 16-19 are unpatentable under 35 U.S.C. § 102(e) over Porcari.
5. Whether claim 12 is unpatentable under 35 U.S.C. § 103(a) over Porcari.
6. Whether claim 15 is unpatentable under 35 U.S.C. § 103(a) over Porcari in combination with Rivette.

7. ARGUMENT

Appellants respectfully submit that the rejections in the Final Office Action are without merit and evidence a misunderstanding of both governing law and the nature of the claims at issue on appeal. Accordingly, your Appellants believe that all of the rejections in the Final Office Action should be reversed, for at least the reasons described below.

A. Claims 1-12 and 14-22 are patentable under the second paragraph of 35 U.S.C. § 112.

In the Final Office Action, the Examiner offers three grounds as basis for rejecting claims 1-12 and 14-22 under § 112, ¶ 2. First, the Examiner takes issue with the term "citation document," as used in claims 1, 16, 21 and 22. Final Office Action, at 2. Next, the Examiner states, "it is unclear what applicant is claiming as the inventive concept." Finally, the Examiner takes the position that "it is unclear what the applicant is claiming in [the limitations that recite displaying, in a second display section, an identifier corresponding to the first reference and, providing an interface element associated with the identifier." Final Office Action, at 4. Appellants respectfully submit that all of the rejections under § 112, ¶ 2 should be reversed.

1. The term "citation document" does not render the claims indefinite.

In rejecting claims 1-12 and 14-22, the Examiner states, "the term citation document is a broad concept and could encompass a traffic ticket." Final Office Action, at 2. As an initial matter, the Final Office Action provides no authority for the proposition that, if a term has a broad meaning, that term necessarily renders any claim using the term indefinite. It is believed that no such authority exists; indeed, the Manual of Patent Examining Procedure (hereinafter, "MPEP") states the opposite: "Breadth of a claim is not to be equated with indefiniteness." MPEP, § 2173.04. The rejection of the claims in this ground should be reversed for that reason alone.

Moreover, the Examiner's objection to the term "citation document" as being overbroad ignores the text of the claims themselves. For instance, claim 1 specifically recites, "wherein the citation document is an electronic document including citation information for one or more prior art reference documents," and independent claims 21 and 22 recite similar language. These recitations alone refute the Examiner's position that "the term citation document . . . could encompass a traffic ticket" and call into question the level of review given the claims by the Examiner.

Further, to the extent there is any question about the meaning of the term "citation information," the Application itself describes the concept of citation information, and claim 2 in fact clearly defines one example of citation information: "the displayed citation information includes information about one or more prior art reference documents submitted to a patent office and an indication of whether each prior art reference document was considered by the patent office." Claim 2; *accord* Application, p. 2, ll. 20-22,. This concept is illustrated by Fig. 20, which depicts a displayed PTO Form 892 (ref. no. 2110) containing citation information about several prior art references.

Accordingly, it is respectfully submitted that the term "citation document" provides no permissible ground for a rejection under § 112, ¶ 2, and that the rejections on this ground should be reversed.

2. The claimed inventive concept is clear.

In rejecting claims 1-12 and 14-22, the Examiner also posits, "[i]t is unclear what applicant is claiming as the inventive concept. . . . [i]t is not clear [from claim 2] what documents are being processed or how they are being processed. Is the inventive concept merely storing the IDS statements processed by the patent office and displaying these IDS statements? If so, this is contradictory to claim 1 wherein it states that a first reference comprising a set of reference information to be disclosed to a patent office, which indicates a future event."

Appellants submit that a careful reading of claims 1 and 2, in light of the written description and figures, reveals the inventive concept being claimed: First, a citation document is displayed for a user. The citation document contains citation information for a plurality of prior art reference documents, which can indicate (as recited by claim 2) whether each of these prior art reference documents has been considered by the a patent office. Second, an identifier for a particular reference is displayed for a user, along with an interface element for that reference. This input element allows the user to provide input about a relationship (or lack thereof) between the citation information in the citation document and the particular reference. Thus, for example, the interface element could be used by the user to indicate that the particular reference is related to citation information in the citation document, implying that the particular

reference already has been considered by the PTO, such that further disclosure of the reference would be unnecessary.

Fig. 20 clearly shows the interplay between the citation document (2010) and the displayed identifier for several particular references (2025), along with their associated interface elements (2022, 2033); the written description explains how this interplay works: "A user may advantageously view and analyze the form 1449 along with the document links to determine whether or not additional information needs to be entered into the IP data processing system. For example, a user may review each cited reference in the form 1449, and enter information corresponding to whether or not a patent office has considered the reference by mouse clicking the input select elements (e.g., yes and no select inputs such as check boxes or check circles) for each of the document links [2025]."

Hence, the inventive concept recited by claim 1 is a method that displays, for a user, both a citation document and identifiers for one or more references, and that allows a user to provide input, with respect to each of the references, that indicates whether a patent office has considered that reference, based on the citation information in the citation document. "By providing the user with an interface where citation information from a patent office can be viewed alongside electronic reference document identifiers, a user may efficiently input information into the system to reconcile and manage the information in an IP data processing system with the information at a patent office." Application, p. 35, ll. 5-9.

One skilled in the art, upon reading claims 1 and 2 in light of the written description and the figures, would easily be able to ascertain this inventive concept. Accordingly, it is believed that the inventive concept of claim 1 (and, similarly, of claims 21 and 22) is sufficiently recited to comply with the second paragraph of § 112, and Appellants submit that the § 112, ¶ 2 rejections on this ground should be reversed as well.

3. The displaying and providing elements of claim 1, and the corresponding elements in claims 21 and 22, are not ambiguous.

The Examiner also finds unclear the limitations of claim 1 that recite "displaying, in a second display section, an identifier corresponding to the first reference," and "providing an

interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference" (along with corresponding limitations in claims 21 and 22).

As an initial matter, Appellants note that the Amendment filed October 19, 2007 Amendment corrected an error in claim 1 introduced by an earlier amendment, which recited "displaying identifiers in a second display section, an identifier corresponding to the first reference." Appellants concede that, prior to the October 19, 2007 Amendment, the displaying element of claim 1 objected to by the Final Office Action indeed was unclear; as amended, however, the element recites "displaying, in a second display section, an identifier corresponding to the first reference." It is submitted that this element is now clearly understandable to one skilled in the art. Claims 21 and 22 did not contain this error, and it is submitted that the displaying elements of claims 21 and 22 fully comply with § 112, ¶ 2.

This leaves the Examiner's objection to the element in claim 1 that recites "providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference" (and the corresponding elements in claims 21 and 22). The Final Office Action does not specify what exactly the Examiner finds unclear, so it is difficult for Appellants to respond to this objection. However, the nature and operation of the interface element (which can be a checkbox, radio button, etc.) is described above, and it is believed that this element, at least when viewed in light of the written description and figures, is sufficiently clear to be easily understandable to one skilled in the art. At the very least, without some sort of explanation from the Examiner of what exactly is objectionable about claims 1, 21 and 22, the rejection of those claims under § 112, ¶ 2 cannot be sustained. Accordingly, Appellants respectfully request that the § 112, ¶ 2 rejections on this ground be reversed as well.

B. Claim 21 is patentable under the first paragraph of 35 U.S.C. § 112.

The Final Office Action rejects claim 21 under 35 U.S.C. § 112, ¶ 1 as being of undue breadth. More specifically, the Examiner contends that claim 21 is a single means claim because it "only defines a processor. It takes more than a processor to execute the instructions of the computer-readable medium." Final Office Action, at 3-4. This rejection is without merit and should be reversed.

First, the case on which the rejection relies, *In re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) defines a "single means claim" to be "a claim drafted in 'means-plus-function' format yet reciting only a single element instead of a combination." 708 F.2d at 713 (emphasis added). The MPEP provides a substantially similar definition: "A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means" MPEP § 2164.08(a) (emphasis added). In contrast, claim 21 does not recite any "means-plus-function" elements. Instead, it recites a processor and a computer readable memory, in addition to several instructions encoded on the computer readable memory. Accordingly, there is no basis for describing claim 21 as a single means claim.

Second, even assuming one of the elements recited by claim 21 might be considered a "means-plus-function" element (and none of the elements reasonably can be construed this way), claim 21 recites two different computer systems, each with a processor, a computer readable medium, and a set of instructions. Altogether, claim 21 recites at least seven different elements. For at least this additional reason, claim 21 properly cannot be rejected as a single means claim, and the rejection of claim 21 under § 112, ¶ 1 should be reversed.

C. Claim 22 is patentable under 35 U.S.C. § 101.

The Final Office Action rejects claim 22 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Specifically, the Examiner argues, "[c]laim 22, as written, is claiming only instructions. Thus, the claim is not statutory." Final Office Action, at 6. This statement is simply incorrect, and it once again calls into question how carefully the Examiner has read the claims. Claim 22 recites "[a] computer program embodied on at least one computer readable memory, the computer program comprising a set of instructions executable by one or

more processors." In other words, claim 22 recites a computer-readable memory having encoded thereon a set of instructions that are executable by a computer processor. This claim format recites statutory subject matter.

Indeed, the very section of the MPEP quoted extensively in the Final Office Action states, "Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim." MPEP § 2101.01. The recitation of a computer-readable memory in claim 22 indicates that the computer program is indeed being claimed as part of a statutory manufacture. More specifically, the MPEP provides, "Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as Non-statutory functional descriptive material. . . . [but] When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should tread the claim as a product claim." *Id.* (emphasis added).

Claim 22 unquestionably recites a computer program in conjunction with such a physical structure (i.e., a computer-readable memory), and claim 22, therefore recites statutory subject matter. The rejection of claim 22 under § 101 should be reversed.

D. Claims 1-12, 14 and 16-19 are patentable under 35 U.S.C. § 102(e) over Porcari.

The Final Office Action rejects claims 1-12, 14 and 16 as being anticipated by Porcari. Final Office Action, at 7.¹ These rejections should be reversed, for at least the reasons described below. Claim 1 is an independent claim, and claims 2-12, 14 and 16-19 depend from claim 1.²

¹ While the Final Office Action purports to reject claim 12 under § 102(e), the Examiner's explanation of the rejections fails to address claim 12, and claim 12 is further rejected under 35 U.S.C. § 103(a) as being unpatentable over Porcari, as noted below. It is the appellants position that claim 12 is allowable over Porcari under both statutory provisions.

² Appellants note that the Final Office Action does not reject claims 21-22 as being unpatentable under either § 102 or § 103, so this Brief does not directly address the patentability of those claims over the cited references.

Porcari is directed to "an intellectual property management system that solicits inventions, docket the invention, and enables collaboration between inventors, attorneys, searchers, draftsmen, patent offices and others through a web-based interface." Porcari, ¶ 0002. In this general aspect, Porcari is similar to the methods recited by the rejected claims, in that it is designed to facilitate the patent application preparation and prosecution process. In addition, Porcari does provide some disclosure of a system for preparing information disclosure statements ("IDS"), which is also similar to some aspects of the rejected claims. However, Porcari fails to teach or suggest the method of managing prior art references recited by claim 1 and therefore cannot anticipate either claim 1 or any of the claims that depend therefrom.

To the extent that Porcari discusses the management of prior art references, it does so in the context of preparing an information disclosure statement. Porcari does not address techniques for managing the information disclosure process, as recited by claim 1, which can, as noted above, help ensure that disclosure obligations are followed consistently. As noted above, one inventive feature of claim 1 is that it allows a user to view both a citation document (such as a PTO form 1449, to name an example), and identifiers of one or more references, in separate display sections on a display. This feature allows the user to ensure that disclosure obligations are adhered to, and that the patent office's records are consistent with the user's records. Porcari does not even approach disclosing such a feature, and it therefore is unsurprising that Porcari fails to teach or suggest multiple elements recited by claim 1.

In rejecting claims 1-12, 14 and 16-19, the Final Office Action relies entirely on two portions of Porcari, which are reprinted below for the Board's convenience. The Examiner relies on paragraphs 0056-0058 in rejecting claims 1-12, 14, and 17-19:

[0056] The system optionally includes a system to reference prior art documents and a method hyperlinks to the stored reference. The USPTO requires disclosure of relevant references and current rules require that paper copies of these references be provided with the patent application. The applicant must later forward these paper copies. The present invention anticipates a method of preparing an Information Disclosure Statement in XML form that contains hyperlinks to identified documents. The USPTO Patent Full Text and Image Database or the European Patent Office (EPO) esp@ce and the EPO maintain databases using Uniform Resource Locator (URL)-based systems where U.S. Pat. No. 5,579,858 may currently be viewed through the hyperlink: "http://164.195.100

Appellants note, however, that several of the distinctions between claim 1 and the cited references would apply with equal force to either claim 21 or claim 22.

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tml/srchnum.htm&r=1&f=G&l=50&s1

[0057] In those instances where there is no internet accessible archive, the present invention contemplates commercial prior art services that will host the document for permanent record storage. Access to the public and patent offices would be through a web interface or URL link as described. One example of a commercial internet-based prior art archive is IP.COM whose web page is www.ip.com. Linking the prior art eliminates the need to submit paper copies. Only one copy of the reference is needed for use with many applications.

[0058] The docketing system records the prior art reference either through a citation system such as patent number (country, number, kind) or through a uniform citation system as are commonly used in technical journals. The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document. The information disclosure system is preferably transmitted as an XML file having hyperlinks to each reference.

Porcari, ¶¶ 0056-0058. In rejecting claim 16, the Examiner also relies on paragraphs 0029 and 0033 of Porcari:

[0029] SMTP 18 provides the formatting for the company specific email system. Various types of email formatting would be evident to those skilled in the art. WSL 30 provides an identification subsystem whereby identification information such as the user's corporate ID and password are authenticated. A password may be established for each disclosure during the initial entry into the system. Thereafter, the password may be used to view the disclosure and view the status thereof. SAFile-up 32 is a software package provided by software artisans that allows the user's PC to couple various documents to the invention disclosure. LDAP 24 is coupled to directory server 16.

...

[0033] Referring now to FIG. 2, a block diagram of the process of the present invention is illustrated. As is described below, a user may be an inventor or just an author that enters the information in to the disclosure system 10. User and inventor are used interchangeably because in most circumstances the user is an inventor but need not be. The author system allows company personnel to enter inventions by non-company personnel in the system. In block 50, the disclosure is prepared on-line. Passwords or other security measures may be employed through the identification subsystem before access to the system may be gained. Preferably, a corporate directory service or other directory information may be used to assist the user in filling out the disclosure. For example, a get employee information block 52 may be coupled to the prepare disclosure on line block 50 to provide the user information at the user's request in response to some identification information such as an email ID, an employee number or the like. This employee user information thus becomes associated with the particular disclosure being prepared. Block 50 may also allow the user to identify other co-inventors and request approval from co-inventors in block 54. The co-inventors of block 54 are preferably notified via an email that the author has prepared an invention disclosure listing them as a co-inventor and that they should either assist in drafting the disclosure or approve the final draft. For convenience, the email notification may include a hyperlink so that the disclosure and a connection with the server may be obtained. In block 50, the inventor may be asked to fill in predetermined disclosure information such as a brief description or comments,

comment on prior art, give a brief description on the new technology provided by the invention, various invention dates, provide classification information such as company classification codes, and miscellaneous other invention information such as whether a government contract was used or if the invention was disclosed to non-company personnel. The prepare disclosure on-line block 50 may also inquire whether other documents exist so that they may be attached to the disclosure as file attachments. The file attachments may be word processing documents, CAD files, presentation documents or various other types of documents.

Id., ¶¶ 0029, 0033.

1. Porcari fails to teach or suggest receiving a citation document.

Neither of these passages (nor, for that matter, any other portion of Porcari) teaches every element of any claim rejected under § 102. For example, the Final Office Action fails to identify anything in Porcari that might teach or suggest "receiving a citation document on the server system, wherein the citation document is an electronic document including citation information for one or more prior art reference documents," as recited by claim 1. Porcari does disclose that "[t]he docketing system prepares an information disclosure statement where the citation system links to a repository in the internet that contains the reference document. The information disclosure system is preferably transmitted as an XML file having hyperlinks to each reference." Porcari, ¶ 0058. However, even assuming, *arguendo*, that the information disclosure statement prepared by the docketing system might be a citation document, Porcari includes no teaching that this information disclosure statement might be received anywhere, let alone on the same server that stores a plurality of references, as recited by claim 1. For at least this reason, Porcari fails to anticipate claim 1, and the rejection of claim 1 should be reversed.

2. Porcari fails to teach or suggest displaying citation information in a first display section.

Moreover, even assuming (without conceding) that the information disclosure statement disclosed by Porcari might be a citation document, Porcari still fails to teach or suggest that this information disclosure statement is ever displayed to a user. Claim 1 recites, *inter alia*, "displaying the citation information in the citation document to a user of a client system, in a first

display section." Porcari teaches the automated preparation of an information disclosure statement, and it teaches that the prepared information disclosure statement "is preferably transmitted as an XML file having hyperlinks to each reference." Porcari, ¶ 0058. Porcari, however, does not ever teach that the information disclosure statement is displayed for the user. (Indeed, Porcari arguably teaches away from the display of the information disclosure statement by teaching that XML is the preferable format for the information disclosure statement – one skilled in the art would appreciate that XML is a preferred format for exchange of information between disparate computer systems, but not for displaying information for a user.) In any event, to support a rejection under § 102, a reference must teach every element of a rejected claim, *see* MPEP § 2131, and the Final Office Action fails to establish that Porcari teaches the display of a citation document. For at least this additional reason, the rejection of claim 1 should be reversed.

3. Porcari fails to teach the use of multiple display sections.

Further, even assuming that Porcari did somehow suggest the display of a citation document (which it does not, for multiple reasons, as discussed above), Porcari still would fail to teach or suggest the specific display techniques recited by claim 1. Specifically, claim 1 recites "displaying the citation information in the citation document to a user of a client system, in a first display section" and "displaying, in a second display section, an identifier corresponding to the first reference," as recited by claim 1. Nothing in the cited passages (or, for that matter, in any other portion of Porcari) teaches or suggests a method that includes displaying citation information in a first display section and displaying an identifier corresponding to a reference in a second display section.

Indeed, the Final Office Action, other than the bare citation of Porcari, fails to identify anything in the cited passages that might read on these claim elements. In responding to Appellants' arguments to this effect, the Examiner states that she "does not find multiple display sections claimed in claim 1." Final Office Action, at 13. The Examiner does not explain this finding, and even a cursory reading of claim 1 reveals a recitation of at least two different display

sections: the first display section, in which the citation information is displayed, and the second display section, which displays an identifier corresponding to a reference.

Hence, it cannot reasonably be disputed that claim 1 recites at least two display sections, and that Porcari fails to teach or suggest these elements. For at least this additional reason, Porcari fails to anticipate claim 1, and the rejection of that claim under § 102 should be reversed.

4. Porcari fails to teach or suggest the interface element recited by claim 1.

Claim 1 further recites "providing an interface element associated with the identifier." Claim 1 further specifies that "the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference." Porcari provides no disclosure that might teach or suggest this element. The Final Office Action takes the position that paragraphs 0056-58 of Porcari teach such an interface element. While paragraph 0056 does disclose the concept of hyperlinks (which might be considered interface elements), Porcari provides not teaching or suggestion that those hyperlinks might be configured to receive, from the user, input comprising information about a relationship between citation information from the citation document and the reference itself. The cited portion of Porcari teaches no other feature that might even be considered an interface element.

In responding to Appellants' arguments, the Examiner also posits, "[a]s for the interface element configured to receive, from the user, input, a keyboard or mouse would read on this limitation." Final Office Action, at 13. While it is true that claim elements must be given a broad construction during prosecution, this interpretation by the Examiner is not reasonable given the disclosure in the Application. The interface elements recited by claim 1 are elements of a graphical user interface, such as radio button, check boxes, and the like, not hardware devices. *See, e.g.*, Application, p. 35, ll. 1-8, Fig. 20. Moreover, even assuming a mouse or keyboard might read on the recited interface element, there is no teaching or suggestion in Porcari that such a mouse or keyboard might be configured to receive "input comprising

information about a relationship between at least some of the citation information in the citation document and the first reference," as required by claim 1.

Hence, the Final Office Action fails to establish that Porcari teaches or suggests the interface element recited by claim 1, and the rejection of claim 1 should be reversed for at least this additional reason.

5. Claims 2-12, 14, and 16-19

Claims 2-11, 14 and 16-19 each ultimately depend from claim 1. For at least the reasons discussed above, the rejection of claim 1 should be reversed. For at least similar reasons, the rejections of claims 2-12, 14, and 16-19 (which each necessarily include the elements of claim 1) should be reversed as well.

E. Claim 12 is patentable under 35 U.S.C. § 103(a) over Porcari.

The Final Office Action rejected claim 12 under § 103(a) as being unpatentable over Porcari. This rejection should be reversed as well. Claim 12 depends from claim 1; as noted above, the rejection of claim 1 should be reversed. For at least similar reasons, the rejection of claim 12 (which necessarily includes all of the elements recited by claim 1) should be reversed as well.

F. Claim 15 is patentable under 35 U.S.C. § 103(a) over Porcari and Rivette.

The Final Office Action rejected claim 15 under § 103(a) as being unpatentable over Porcari, in view of Rivette. Claim 15 ultimately depends from claim 1 and therefore includes all of the elements of claim 1. As noted above, claim 1 is allowable over Porcari. The Final Office Action relies on Rivette only as teaching that "the input select element is an electronic add button, and in accordance with mouse clicking the electronic add button, the information is entered by loading an electronic document from an external source."³ The Final Office Action does not identify, and a review of Rivette does not reveal, any teaching or

³ To alleviate any confusion, Appellants note for the Board that the language quoted from the final office action is similar to language in a prior version of claim 15.

suggestion in Rivette of the elements of claim 1 missing from the disclosure of Porcari, as discussed above.


Accordingly, Appellants submit that claim 1 is allowable over the combination of Porcari and Rivette, and that claim 15, accordingly, is allowable at least by virtue of its dependence from claim 1. The rejection of claim 15 should be reversed.

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejections of claims 1-12 and 14-22 should be reversed.

Dated: October 22, 2007

Respectfully submitted,


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9. CLAIMS APPENDIX

1. A computer implemented method of processing documents received on a server system comprising:

storing a plurality of references on the server system, wherein the plurality of references are electronic documents, the plurality of references comprising a first reference comprising a set of reference information to be disclosed to a patent office;

receiving a citation document on the server system, wherein the citation document is an electronic document including citation information for one or more prior art reference documents;

providing communication between the server system and a client system, wherein the client system is configured to provide interaction between a user and the server system;

displaying the citation information in the citation document to a user of a client system, in a first display section; and

displaying, in a second display section, an identifier corresponding to the first reference; and

providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.

2. The method of claim 1 wherein the displayed citation information includes information about one or more prior art reference documents submitted to a patent office and an indication of whether or not each prior art reference document was considered by the patent office, and the input received from the user indicates whether or not the first reference was considered by the patent office.

3. The method of claim 1 wherein displaying the citation information includes displaying an image file of a form received from a patent office.

4. The method of claim 3 wherein the form is a notice of references cited by a patent applicant.
5. The method of claim 3 wherein the form is a notice of references cited by a patent office.
6. The method of claim 1 wherein the first reference is a patent, and wherein the identifier comprises a patent number associated with the patent.
7. The method of claim 6 wherein the identifier comprises a United States Patent number.
8. The method of claim 6 wherein the identifier comprises a foreign patent number.
9. The method of claim 1 wherein the reference is a published patent application and identifier comprises a serial number of the published patent application.
10. The method of claim 1 wherein the identifier comprises a title of a publication.
11. The method of claim 1 wherein the identifier comprises a link to the first reference.
12. The method of claim 1 wherein the interface element comprises a yes check box and a no check box and wherein the yes check box is mouse is configured to receive input indicating that the first reference has been considered by a patent office, and the no check box is mouse is configured to receive input indicating that the first reference has not been considered by the patent office.
13. (Canceled)

14. The method of claim 1 wherein the displayed citation information includes information about one or more prior art reference documents discovered by a patent office, and the input received from the user includes information about additional electronic documents corresponding to the references discovered by the patent office but not stored on the server system.

15. The method of claim 14 wherein the interface element is configured to allow the user to indicate an additional electronic document from an external source, and the information is entered by loading an electronic document from an external source.

16. The method of claim 1 wherein the citation document is received by electronic mail.

17. The method of claim 1 wherein at least one of the plurality of references stored on the server system is an electronic version of a United States Patent.

18. The method of claim 1 wherein at least one of the plurality of references stored on the server system is an electronic version of a foreign patent document.

19. The method of claim 1 wherein at least one of the plurality of references stored on the server system is an electronic version of a publication.

20. The method of claim 1, further comprising:
displaying, in the second display section, a plurality of identifiers, each of the plurality of identifiers corresponding to one of the references stored on the server system; and
providing a plurality of interface elements, each of the plurality of interface elements being associated with one of the plurality of identifiers.

21. A system for processing documents, the system comprising:
a server system comprising a first processor and a first computer readable memory comprising a first set of instructions executable by the first processor, the first set of instructions comprising:

instructions to store a plurality of references, wherein the plurality of references are electronic documents, the plurality of references comprising a first reference comprising a set of reference information to be disclosed to a patent office; and
instructions to receive a citation document, wherein the citation document is an electronic document comprising citation information for one or more prior art reference documents; and

a client system in communication with the server system, the client system comprising a second processor and a second computer readable memory comprising a second set of instructions executable by the second processor, the second set of instructions comprising:

instructions to display for a user, in a first display section, the citation document;

instructions to display, in a second display section, an identifier corresponding to the first reference; and

instructions to provide an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.

22. A computer program embodied on at least one computer readable memory, the computer program comprising a set of instructions executable by one or more processors, the set of instructions comprising:

instructions to store a plurality of references, wherein the plurality of references are electronic documents, the plurality of references comprising a first reference comprising a set of reference information to be disclosed to a patent office; and

instructions to receive a citation document, wherein the citation document is an electronic document comprising citation information for one or more prior art reference documents;

instructions to display for a user, in a first display section, the citation document;

instructions to display, in a second display section, an identifier corresponding to the first reference; and

instructions to provide an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.

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10. EVIDENCE APPENDIX

None.

11. RELATED PROCEEDINGS APPENDIX

Opinion of the Board in Appeal No. 2007-0776, Application Serial No.
09/996,338, decided September 27, 2007 (attached).

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFRY J. GRAINGER

Appeal 2007-0776
Application 09/996,338
Technology Center 3600

Decided: September 27, 2007

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jeffry J. Grainger (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 4-9, 11-13, and 19-34, all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is to a computer-implemented method of facilitating the preparation of intellectual property documents, such as patent applications, securing intellectual property rights and managing intellectual property assets (Specification 1:11-15). Claim 19, reproduced below, is representative of the subject matter on appeal.

19. A method of managing electronic documents related to a plurality of patent applications, the method comprising:

for a plurality of different and unrelated technology developers, allowing users from each such technology developer to create a plurality of invention disclosures for each respective technology developer;

receiving the plurality of invention disclosures from the users from each technology developer at a server system over a network and storing each invention disclosure in one of a plurality of collections of electronic documents and data in a computer-readable memory operatively coupled to the server system, wherein each collection is associated with one of the plurality of patent applications and assigned to at least one group that can be used in determining whether a user may access electronic documents and data in the particular collection;

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storing, in the database, additional electronic documents associated with at least some of the plurality of invention disclosures for each technology developer;

maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents such that at least some users associated with each technology developer in the plurality of technology developers can access selected ones of the electronic documents associated with invention disclosures created for the respective technology developer and such that users associated with a particular technology developer cannot access electronic documents in the database associated with invention disclosures of other unrelated technology developers in the plurality of technology developers;

maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents for users associated with a plurality of patent firms such that at least some users from selected ones of the patent firms have rights to view selected invention disclosures stored in the collections and selected electronic documents stored in the collection selected invention disclosure is stored in and create and modify patent applications prepared for the selected invention disclosures;

receiving any such created patent application at the server system and storing it in the collection of electronic documents the respective invention disclosure is stored in;

maintaining and enforcing rights to file patent applications in a patent office for users associated with the plurality of law firms such that only selected users from the law firms have rights to file patent applications in the patent office; and

electronically receiving a request from a user to file a particular patent application for a first technology developer in the plurality of technology developers, determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request;

wherein each user from the plurality of different and unrelated technology developers and each user from the plurality of patent law firms is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in a particular collection of electronic documents and wherein each user is assigned one or more roles that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection; and

wherein when a user generates a request to perform an operation on an electronic document in a particular collection of electronic documents, in response to receiving the request, determining (i) a first group to which the user is assigned; (ii) a second group to which the electronic document assigned; (iii) one or more roles to which the user is assigned (iv) unit level access information for the particular collection of electronic documents and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned,

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the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Takano	US 6,434,580 B1	Aug. 13, 2002
Serbinis	US 6,584,466 B1	Jun. 24, 2003

The Appellant seeks our review of the rejection of claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis.

ISSUE

The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis. This issue turns on whether:

- 1) Takano and Serbinis, when considered collectively, teach or suggest all of the elements of the claimed invention;
- 2) The combined teachings of Takano and Serbinis would have led one having ordinary skill in the art to the claimed invention; and
- 3) The Appellant has shown that one having ordinary skill in the art at the time the invention was made would not have had a reasonable expectation of success in combining the teachings of Takano and Serbinis.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Takano discloses a method and program for preparing patent specifications with inventors and those in charge of filing the patent applications using a plurality of computers connected to a communications network, such as the Internet (Takano, col. 1, ll. 13-18). In particular, Takano's system includes client computers 100 and 200 and a server computer 300, which are connected to one another via a communications network, such as the Internet (Takano, col. 5, ll. 46-51).
2. Takano discloses that the inventor uses client computer 100 to prepare draft data on a specification for a patent application (Takano, col. 5, ll. 55-61).
3. Takano discloses that a person working in the company application processing department or an outside person at a law firm representing the company (collectively referred to hereafter as the patent attorney) uses client computer 200 to revise the draft data provided by the inventor and prepare the final specification to be filed with the Patent Office (Takano, col. 6, ll. 5-13).
4. Takano describes that once the inventor has registered the draft data for the specification on the server computer 300, the patent attorney can

access the draft on client computer 200 in order to revise it (Takano, col. 8, ll. 7-11). Takano describes that the system may restrict the patent attorney's access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to inventors belonging to a specific department (Takano, col. 8, ll. 14-18).

5. Similarly, Takano describes that after the patent attorney finishes revising the draft, the inventor can then review the revisions (Takano, col. 10, ll. 8-15). Takano again describes that the system may restrict the inventor's access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to the inventor concerned (Takano, col. 10, ll. 15-22).
6. As such, Takano imposes access controls on the information stored on its server computer 300 depending on the group (e.g., department) from which the information came, or depending on the identity of the user (e.g., the patent attorney or inventor) attempting to access the information. The identity of the user, as described in Takano, is the user's role (e.g., inventor or patent attorney).
7. Takano also discloses receiving a request from a user to file a patent application, determining if the system has rights to file the application, and, if so, using a patent application filing component (Fig. 18) (element 205 (patent application document data transmitting means)) to file the application in the patent office.

8. In particular, Takano describes a sixth embodiment of the system (Takano, col. 16, l. 15 – col. 18, l. 18), which includes a client computer 500 to be used by the Patent Office to receive patent application filings transmitted from the patent attorney via client computer 200 (Takano, col. 16, ll. 45-50). As we found *supra*, Takano teaches that the DMS system can be configured so that the patent attorney may be allowed to access only those patent applications that pertain to a certain group, such as inventors belonging to a specific department (FF 4). As such, the DMS system checks to see if the patent attorney has rights to access documents before granting the user access to such documents.
9. Takano further discloses a template downloading means 105 on client computer 100 that reads in document data in a specification form for a patent application so that the inventor has to fill in the blanks in the template to complete the draft application (Takano, col. 9, ll. 11-22).
10. Takano further discloses that the inventor completes an invention report to accompany the patent application draft, wherein the inventor is prompted by the field headings to complete the input fields via an invention report information screen (Takano, col. 7, ll. 11-26; Fig. 3).
11. Serbinis discloses an apparatus and methods for managing electronic documents over open networks, such as the Internet, to permit users to store, retrieve, and collaboratively manipulate files (Serbinis, col. 1, ll. 6-9). Serbinis discloses that the apparatus and method includes an Internet-based document management system (DMS) wherein an electronic

document may be stored on an Internet-accessible server and accessed using a previously-known web browser, downloaded for review or manipulation, and then returned to the server for access by further users (Serbinis, col. 3, ll. 15-20).

12. The server is programmed to provide a plurality of document management services, including document storage and retrieval, collaborative file sharing and workflow services for electronic documents, an electronic document delivery service, and a document distribution service (Serbinis, col. 4, ll. 18-23).
13. Serbinis describes that the server is also programmed to perform a security function, to verify or define a requestor's ability to access an electronic document (Serbinis, col. 3, ll. 32-34).
14. Serbinis discloses that each user of the DMS system has access to one or more document groups, where each document group comprises a collection of document objects (Serbinis, col. 7, ll. 18-21). Each document stored in the DMS system also has an associated state, e.g., pending, active, archived, canceled, and deleted (Serbinis, col. 7, l. 63 – col. 8, l. 1). Serbinis discloses that certain users have access to particular document based on the state associated with the document. For example, document instances marked “active” are accessible by all Authorized Users, but document instances marked “archived” are accessible only to the document Originator (Serbinis, col. 8, ll. 10-17). As such, Serbinis discloses use permissions based on the user's role, e.g., if the user is in

the role of the Originator, the user can access an archived document and if the user is in the role of an Authorized User, the user is restricted from accessing the same archived document.

15. Serbinis further describes that a document Originator, in using the DMS system, uploads and stores a previously-created document in the system and then defines one or more Authorized Users who may access the document (Serbinis, col. 8, l. 64 – col. 9, l. 3 and col. 9, ll. 19-22). The Originator also specifies the types of access that each Authorized User is to receive, e.g., retrieve, review, or modify (Serbinis, col. 9, ll. 22-28). In this example, if the Originator designates only one Authorized User, then that user's role is as the sole Authorized User, and the system imposes the use permissions (e.g., retrieve, review, or modify) for that document based on the type of access previously-defined by the Originator for the user role.
16. Serbinis further discloses that users are granted rights via the DMS authorization system, which defines the rights users have on particular document objects, document instances, and document groups (Serbinis, col. 12, ll. 24-27). For example, for a particular document uploaded to the system, the Originator may have owner rights, retrieval rights, viewing rights, and the right to revoke access by a previously-specified Authorized User, while an Authorized User may have only viewing and retrieval rights (Serbinis, col. 12, ll. 38-42). As such, Serbinis discloses another example of imposing use permissions based on the user's role

- (e.g., Originator versus Authorized User) to determine whether the user can perform an operation on an electronic document, such as changing the list of Authorized Users associated with the electronic document.
17. As such, we find that Serbinis discloses several examples of how the DMS system imposes use permissions in user roles to determine whether a user can perform an operation on an electronic document.
 18. Serbinis further discloses that the DMS system database includes document information, including information on rights for each document and rights for a group of documents (see Fig. 2, block 61).
 19. Serbinis also discloses that the DMS system database includes user information tables 62 that include user group information, i.e., information on the group of users that the user is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group (Serbinis, col. 6, ll. 41-46 and Fig. 2, block 62).
 20. As such Serbinis discloses that the DMS system, when receiving a request to access a document, determines (i) a first group to which the user is assigned (i.e., is the user on the Originator's list of Authorized Users for this document? (FF 15) Or is the user part of a group, and if so, what document rights are associated with that group? (FF 19)), (ii) a second group to which the electronic document is assigned (i.e., is the document assigned to the group of archived documents accessible only by the Originator? (FF 14)), (iii) one or more roles to which the user is

assigned (i.e., is the user making the request for the archived document assigned the role of the document Originator? (FF 14) Or, does the user have owner rights to the document in the role as an Originator? (FF 16)), and (iv) unit level access information for the document (i.e., Is the user permitted access to this group of documents and further is the user permitted access to the particular requested document with the group (FF18)).

21. Serbinis further suggests that information from its DMS system can be presented to the user on a web page via a web browser without the need for a specialized client application (Serbinis, col. 2, ll. 3-20).
22. Serbinis defines a “closed system” as “a closed client/server architecture network, such as a local area network or wide area network” and provides an example of an “open system” as one that makes electronic documents available via the Internet (Serbinis, col. 1, ll. 12-15 and col. 2, ll. 12-13).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any

differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine.” *Id.* at 1739, 82 USPQ2d at 1395. “In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1739-40, 82 USPQ2d at 1395. “*Sakraida and Anderson’s-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 1740, 82 USPQ2d at 1395.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

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Id. at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Appellant summarizes his arguments as follows:

Takano and Serbinis each fail (either individually or collectively) to teach or suggest each element of any pending claim. Further, the Final Office Action does not make the requisite showing of a teaching or suggestion to combine Takano and Serbinis in the contemplated manner. Finally, there would be no reasonable expectation of success in the proposed combination of Takano and Serbinis.

(Appeal Br. 8).¹ We address each of these arguments in turn.

¹ Only those arguments actually made by the Appellant have been considered in this decision. Arguments which the Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2006).

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First Contention: Takano and Serbinis fail to teach or suggest each element of any pending claim.

The Appellant elaborates on his first contention by pointing to specific claim language in independent claims 19, 20, and 27, and in dependent claim 8, that he contends are neither taught nor suggested by Takano and Serbinis. In particular, the Appellant contends that the subject matter of claims 19, 20, and 27 is not obvious because “[n]either Takano nor Serbinis teach[es] the use permissions in user roles to determine whether a user can perform an operation on an electronic document” (Appeal Br. 10-12). We disagree.

Takano discloses a method and program for preparing patent specifications with inventors and those in charge of filing the patent applications using a plurality of computers 100, 200, and 300 connected to a communications network, such as the Internet (FF 1). Takano discloses that the inventor uses client computer 100 to prepare draft data on a specification for a patent application (FF 2), and that a patent attorney uses client computer 200 to revise the draft data provided by the inventor and prepare the final specification to be filed with the Patent Office (FF 3). Takano describes that the system may restrict the patent attorney’s access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to inventors belonging to a specific department (FF 4). Similarly, Takano describes that the system may restrict the inventor’s access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to the inventor concerned (FF 5). As such, Takano imposes access controls on the

information stored on its server computer 300 depending on the group (e.g., department) from which the information came, or depending on the identity of the user (e.g., the patent attorney or inventor) attempting to access the information (FF 6). In this case, the identity of the user, as described in Takano, is the user's role (e.g., inventor or patent attorney) (FF 6).

Serbinis discloses further access controls within the context of a document management system. Serbinis discloses an apparatus and method for managing electronic documents using an Internet-based document management system (DMS) wherein an electronic document may be stored on an Internet-accessible server and accessed using a previously-known web browser, downloaded for review or manipulation, and then returned to the server for access by further users (FF 11). The server is programmed to provide a plurality of document management services and is also programmed to perform a security function, to verify or define a requestor's ability to access an electronic document (FF 12, 13).

Serbinis discloses that each user of the DMS system has access to one or more document groups and each document stored in the DMS system also has an associated state, such that certain users have access to particular documents based on the state associated with the document (FF 14). For example, document instances marked "active" are accessible by all Authorized Users, but document instances marked "archived" are accessible only to the document Originator (FF 14). As such, Serbinis discloses use permissions based on the user's role, e.g., if the user is in the role of the Originator, the user can access an archived document

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and if the user is in the role of an Authorized User, the user is restricted from accessing the same archived document (FF 14).

Serbinis further describes that a document Originator defines one or more Authorized Users who may access the document and also specifies the types of access that each Authorized User is to receive, so that if the Originator designates only one Authorized User and that user's role is as the sole Authorized User, then the system imposes the use permissions based on the type of access previously-defined by the Originator for the Authorized User role (FF 15).

Serbinis further discloses that users are granted rights based on particular document objects, document instances, and document groups (FF 16). For example, for a particular document uploaded to the system, the Originator may have owner rights, retrieval rights, viewing rights, and the right to revoke access by a previously-specified Authorized User, while an Authorized User may have only viewing and retrieval rights (FF 16). As such, Serbinis discloses another example of imposing use permissions based on the user's role (e.g., Originator versus Authorized User) to determine whether the user can perform an operation on an electronic document, such as changing the list of Authorized Users associated with the electronic document (FF 16).

As such, we find that Serbinis discloses several examples of how the DMS system imposes use permissions in user roles to determine whether a user can perform an operation on an electronic document (FF 17). Accordingly, we find the Appellant's argument that neither Takano nor Serbinis discloses use permissions in user roles to be without merit.

The Appellant further contends that “[n]either Serbinis nor Takano teaches the use of a particular combination of (i) a user group, (ii) a document group, and (iii) permissions associated with user roles to determine whether a user can perform an operation on an electronic document, as recited by claim 27” (Appeal Br. 13). The Appellant similarly contends that “Serbinis and Takano each fail (either individually or collectively) to teach or suggest using this combination, along with (iv) unit-level access information, to make such a determination, as recited by claims 19 and 20” (*Id.*). We disagree.

Serbinis, for example, discloses that the DMS system database includes document information, including information on rights for each document and rights for a group of documents (FF 18). Serbinis also discloses that the DMS database includes user information tables that include user group information, i.e., information on the group of users that the user is a part of, including the group’s security information, and document rights for the group (FF 19). Further, as found *supra*, the DMS system of Serbinis maintains a list of Authorized Users designated by an Originator (FF 15), information on the state of each document which dictates which users have access to the document (FF 14), and information about the role of a user as Originator or Authorized User (FF 16).

As such Serbinis discloses that the DMS system, when receiving a request to access a document, determines (i) a first group to which the user is assigned (i.e., is the user on the Originator’s list of Authorized Users for this document? (FF 15) Or, is the user part of a group, and if so, what document rights are associated with that group (FF 19)), (ii) a second group to which the electronic document is

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assigned (i.e., is the document assigned to the group of archived documents accessible only by the Originator? (FF 14)), (iii) one or more roles to which the user is assigned (Is the user making the request for the archived document assigned the role of the document Originator? (FF 14) Or, does the user have owner rights to this document in the role as an Originator (FF 16)), and (iv) unit level access information for the document (i.e., Is the user permitted access to this group of documents and further is the user permitted access to the particular requested document with the group (FF 18)). (FF 20.) Accordingly, we find the Appellant's argument that neither Serbinis nor Takano teaches the use of a particular combination of (i) a user group, (ii) a document group, (iii) permissions associated with user roles, and (iv) unit-level access information to determine whether a user can perform an operation on an electronic document to be without merit.

The Appellant further contends that the subject matter of claims 19 and 20 is not obvious because Serbinis and Takano do not teach or suggest "determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request" (claim 19) or "a patent application filing component" (claim 20) (Appeal Br. 14-15). We find the Appellant's arguments unpersuasive.

Takano discloses receiving a request from a user to file a patent application, determining if the system has rights to file the application, and, if so, using a patent application filing component to file the application in the patent office (FF 7). In particular, as described in Takano, the DMS system checks to see if the patent attorney has rights to access documents before granting the user access to such

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documents, and thus the system allows only those patent attorneys with the appropriate rights to file patent applications at the patent office (FF 8).

The Appellant further contends that the subject matter of dependent claim 8 is not obvious because neither of the cited references teaches or suggests that the invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a Web page (Appeal Br. 15).

Takano discloses a template downloading means 105 on client computer 100 that reads in document data in a specification form for a patent application so that the inventor has to fill in the blanks in the template to complete the draft application (FF 9). Takano further discloses that the inventor completes an invention report to accompany the patent application draft, wherein the inventor is prompted by field headings to complete the input fields via an invention report information screen (FF 10). The Appellant contends that “[p]roviding a template for a specification form is in no way similar to presenting questions to be answered by an inventor.” We fail to see a patentable difference between the prompts or input fields described in Takano and a list of questions posed to the user. In either case, whether the prompts are in the form of phrases, statements, or questions, the words prompt the user to enter information. Although Takano discloses that communications between the inventor and the server occur via the Internet, Takano does not explicitly state that it uses web pages for this communication.

Serbinis, however, clearly teaches that information from its document management system can be presented to the user on a web page via a web browser without the need for a specialized client application (FF 21). We find that it would

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have been obvious to one having ordinary skill in the art at the time the invention was made to have presented Takano's patent specification templates and invention report information screens to users via a web page because both Takano and Serbinis disclose access via the Internet and Serbinis suggests using web pages to display information to the user to eliminate the need for a specialized client application. *See KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396 ("if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.") As such, we find the Appellant's argument that neither Takano nor Serbinis discloses that the invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a web page to be unpersuasive.

Second Contention: The Final Office Action does not make the requisite showing of a teaching or suggestion to combine Takano and Serbinis in the contemplated manner.

The Appellant elaborates on his second contention by arguing that because Takano is directed to a closed system and thus does not contemplate a system with multiple, independent entities, Takano does not have any need for the access control protocols of Serbinis (Appeal Br. 17). The Appellant further argues that the Examiner failed to identify how the teachings of Serbinis might provide additional benefit in the areas of collaborative file sharing and workflow,

document delivery, and document distribution over what Takano already provides (*Id.*).

As we found *supra*, Takano discloses that its DMS system is designed to be used via the Internet (FF 1). As such, we find no basis for the Appellant's contention that Takano is directed to a closed system. Serbinis defines a "closed system" as "a closed client/server architecture network, such as a local area network or wide area network" and provides an example of an "open system" as one that makes electronic documents available via the Internet (FF 22). As such, both Takano and Serbinis envision document management systems that use open systems (e.g., accessible via the Internet) to make documents available to users. Further, we disagree with the Appellant's contention that Takano does not have any need for access control protocols. On the contrary, as we found *supra*, Takano implements access controls to restrict inventor and patent attorney access to information on the server computer 300 (FF 4, 5).

Further, the Appellant's argument that the Examiner fails to identify how the teachings of Serbinis might provide additional benefit to Takano misses the mark. As demonstrated by our findings of fact, Serbinis clearly discloses improvements to the access control restrictions in a document management system. These improvements add additional layers of security to the documents. Takano deals with the highly confidential, proprietary, and privileged communications between attorneys and clients regarding inventions and patent applications. It would have been obvious to one having ordinary skill in the art to have implemented the improved access control restrictions, as taught by Serbinis, in the system of

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Takano, to better protect access to highly sensitive patent application information and to better ensure control over the disclosure of the information contained therein. *See KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396 (“if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”)

Third Contention: There would be no reasonable expectation of success in the proposed combination of Takano and Serbinis

The Appellant elaborates on his third contention by arguing that because the system of Takano uses specialized software on the client and server, if a user attempted to connect to the DMS of Serbinis with the client software of Takano, there would be no reasonable expectation that such a connection would be successful (Appeal Br. 19). In particular, the Appellant asserts that “nothing in Takano teaches or suggests that the client software of Takano might be configured to interoperate generally with a web server using HTTP and servlets” (*Id.*). The Appellant’s argument seems to amount to a contention that because the system of Takano would require modification, there would have been no reasonable expectation of success. This is not the test for reasonable expectation of success and the law on motivation to combine does not require an explicit teaching or suggestion in the reference for the modification. *See KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396 (“the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the

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inferences and creative steps that a person of ordinary skill in the art would employ.”) Additionally, the Appellant has not demonstrated unpredictability of this field of art at the time of the invention or even that the modifications to Takano would have been beyond the skill level of one of ordinary skill in the art at the time of the invention. As noted by the Examiner (Answer 48), the Appellant has provided no evidence to support his assertion that a person having ordinary skill in the art would have had no reasonable expectation of success in the combination of Takano and Serbinis. Without more, we find the Appellant’s argument unpersuasive. As such, we find that a prima facie case of obviousness of the claimed invention exists in view of the combined teachings of Takano and Serbinis, and the Appellant’s arguments have failed to persuade otherwise.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis.

DECISION

The decision of the Examiner to reject claims 4-9, 11-13, and 19-34 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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